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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/511,171	02/22/2000	Paramvir Bahl	MS1-493US	3218

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EXAMINER	
HENEGHAN, MATTHEW E	

ART UNIT	PAPER NUMBER
2134	11

DATE MAILED: 03/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/511,171	BAHL ET AL.	
	Examiner	Art Unit	
	Matthew Heneghan	2134	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 February 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-49* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-49* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *18 February 2000* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *7,8*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-49 have been examined. Claims 14, 23, 34, 42, and 43 have been amended in response to the first office action.

Information Disclosure Statement

2. The following Information Disclosure Statements in the instant application submitted subsequent to the first office action have been fully considered:

Paper No. 7, filed 1 October 2003.

Paper No. 8, filed 9 February 2004.

Drawings

3. In view of the amendments to the specification, all objections to the drawings are withdrawn.

Specification

4. In view of the amendments to the specification, all objections to the specification are withdrawn.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 14, 15, 17, 19-21, 23, 24, 27-29, 43-45, and 47-49 are rejected under 35 U.S.C. 102(b) as being anticipated by WIPO Patent Application No. 99/01969 from Xu et al.

As per claims 14, 15, 23, 24, 43-45, and 49, the network access method disclosed by *Xu* includes a host network allowing wireless public internet access (see page 6, lines 9-12 and 22), an authentication component allowing connection to any ISP (see page 7, lines 22-24), modules for end users to communicatively access the network (see page 6, lines 4-8), and local and globally accessible authentication databases (see page 7, line 26 to page 8, line 4), and there exists a plurality of wireless access points which users use to interface the network (see page 2, lines 16-20).

As per claim 17, the system links a user to the correct authentication database, and the user authenticates directly with it, in an end-to-end manner (see page 13, lines 17-31).

As per claims 19, 27, 28, and 47, the RADIUS authentication server notifies the authentication component of a successful authentication (see page 25, lines 9-11).

As per claims 20 and 21, the RADIUS authentication server is configured to provide accounting information about the user session to the authentication component, including the Account Session Time, which is sufficient to compute billing. (see page 27, line 24 to page 29, line 24).

As per claims 29 and 48, the authentication component receives a unique IP address for each user from the authentication server at the end of the authentication sequence, which it must then transmit to the user. A user's IP address is enclosed within all internet TCP/IP transmissions (see page 27, lines 7-9).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1-6, 8-13, 16, 22, 26, 33-42, and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over WIPO Patent Application No. 99/01969 from Xu et al. as applied to claim 14 above, and further in view of U.S. Patent No. 6,243,754 to Guerin et al.

Regarding claim 1-4, 8-13, 22, and 33-42, Xu does not disclose that any user not existing a preexisting affiliation may gain access.

The network selection system disclosed by Guerin allows for a user to select an ISP without having any pre-existing ISP affiliation, using a direct channel to another user providing ISP information before selecting a provider (see column 5, lines 23-34). Guerin further suggests that this allows for the selection of an ISP in a dynamic fashion (see column 2, lines 5-7).

Therefore it would be obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Xu by allowing the selection of an ISP using the mechanism disclosed by Guerin, in order to allow for the selection of an ISP in a dynamic fashion.

As per claim 6, the RADIUS authentication used a shared secret between the user and the authentication server, so that the authentication component is not aware of that information (see page 24, lines 10-14).

Regarding claims 5, 16, 26, and 46, the only time at which the shared secret does not protect the information from the authentication component in Xu's system is during the initial sequence, when the authentication component uses the caller's phone number for the purposes of routing. The combining of Guerin to Xu removes the need for this functionality, since the initial transaction is performed directly. Therefore, the invention can perform without the authentication component being privy to any authentication information.

7. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over WIPO Patent Application No. 99/01969 from Xu et al. in view of U.S. Patent No. 6,243,754 to

Guerin et al. as applied to claim 6 above, and further in view of U.S. Patent No. 5,742,763 to Jones.

The invention disclosed by *Xu* discloses that authentication takes place, but does not specifically disclose the usage of the SSL protocol for the authentication.

Jones discloses a network environment in which authentication and encryption protocols are used, as appropriate, and specifies that SSL is an appropriate protocol for such an environment (see column 3, lines 57-60).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to, when performing the authentication disclosed by *Xu*, use SSL when encrypting authentication data, as disclosed by *Jones*, as that is an appropriate network encryption protocol.

8. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over WIPO Patent Application No. 99/01969 from Xu et al. as applied to claim 17 above, and further in view of U.S. Patent No. 5,742,763 to Jones.

The invention disclosed by *Xu* discloses that authentication takes place, but does not specifically disclose the usage of the SSL protocol for the authentication.

Jones discloses a network environment in which authentication and encryption protocols are used, as appropriate, and specifies that SSL is an appropriate protocol for such an environment (see column 3, lines 57-60).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to, when performing the authentication disclosed by

Xu, use SSL when encrypting authentication data, as disclosed by *Jones*, as that is an appropriate network encryption protocol.

9. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over WIPO Patent Application No. 99/01969 from Xu et al. as applied to claim 24 above, and further in view of U.S. Patent No. 6,145,002 to Srinivasan.

Xu does not disclose the use of a web page to review authentication information.

The ISP access system of Srinivasan displays information from the server to the user via a web page (see column 10, lines 17-36). Srinivasan further discloses that using browser software (for web pages) facilitates dial-up Internet request procedures (see column 2, lines 45-49).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to modify the system disclosed by Xu by adding the web page interface disclosed by Srinivasan, in order to facilitate dial-up Internet request procedures.

10. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over WIPO Patent Application No. 99/01969 from Xu et al. as applied to claim 29 above, and further in view of WIPO Application No. 98/32254 from Scholnick et al.

The system disclosed by *Xu* does not include a unique encrypted token being sent to the user after authentication.

Scholnick discloses the use of encrypted identifying tokens in network transactions, and notes that this provides anonymity to transactions by shielding the two ends of the connection.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add the use of encrypted identifying tokens, as disclosed by *Scholnick*, to the invention disclosed by *Xu*, in order to enhance the anonymity of a connection.

11. Claims 31 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over WIPO Patent Application No. 99/01969 from Xu et al. as applied to claim 23 above, and further in view of U.S. Patent No. 5,742,598 to Dunn et al.

In the network disclosed by *Xu*, it is not explicitly stated that the access points define a wireless subnet, or that they are deployed in a publicly accessible area.

Dunn discloses a model of a network in which it is noted that a subnetwork is a cellular (wireless) network, which is, by its nature, publicly accessible, and that this model would provide a plurality of communications services (see column 3, lines 11-27).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to deploy the set of user nodes disclosed in *Xu* as a subnet in a wireless cellular network, as described in *Dunn*, in order to provide a plurality of communications services.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Claims 1-49 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-43, 46, 48-58, and 78-87 of copending Application No. 09/565,558 in view of WIPO Patent Application No. 99/01969 from Xu et al. in view of U.S. Patent No. 6,243,754 to Guerin et al. further in view of U.S. Patent No. 5,742,763 to Jones further in view of U.S. Patent No. 6,145,002 to Srinivasan further in view of U.S. Patent No. 5,742,598 to Dunn et al.

The claims of 09/565,558 disclose a network as described, but do not teach to selecting ISPs.

Xu discloses the selecting of an ISP (described above), and further suggests that this can provide for Internet and corporate network access (see page 2, lines 22-25).

Therefore, it would be obvious to one of ordinary skill in the art at the time the invention was made to modify the system disclosed by 09/565,558 to allow the selecting

of an ISP, as disclosed by Xu, as this can provide for Internet and corporate network access.

All other art may be combined with the claims of 09/565,558 as with Xu, as described above.

This is a provisional obviousness-type double patenting rejection.

Response to Arguments

13. Applicant's arguments, see Paper No. 10, filed 17 February 2004, with respect to the rejection(s)of claim(s) 1-13, 16, 22, 25, 26, 34-42, and 46 under 35 U.S.C. 102(b) and 35 U.S.C. 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, new grounds of rejection are made as described above. Applicant's arguments with respect to the rejections of claims 14, 15, 17-21, 23, 24, 27-33, 43-45, and 47-49 under 35 U.S.C. 102(b) and 35 U.S.C. 103(a) have been fully considered but they are not persuasive.

Regarding Applicant 's arguments as to the meaning of the wording in claim 1 (see Paper No. 10, pp. 23 and 24), particularly the term "independent of any user affiliation with any Internet Service Providers (ISPs)," it is agreed that the phrase teaches to the invention being accessible to any potential user, even one who is devoid of any ISP association as of the time that he or she first attempts to use the system. It would be impossible for the invention as disclosed by Xu to be used by a user who did not have a pre-existing account with at least one ISP with which the invention is

communicatively connected. The grounds of rejections for claims 1-13 have therefore been replaced.

Regarding Applicant 's arguments to the rejection of claim 5 (see Paper No. 10, p. 25), it is agreed that Xu's system examines parts of the authentication data for routing purposes only, due to its need to differentiate the host network's own subscribers from non-subscribers. The grounds of rejection for claim 5 have therefore been further modified.

Regarding Applicant 's arguments as to the meaning of the wording in claim 14 (see Paper No. 10, pp. 26 and 27), particularly the term "without requiring the user to be affiliated with a particular Internet Service Provider (ISP)," the system disclosed by Xu does not require a user to be affiliated with a particular ISP, though it does require affiliation with at least one of a particular set of ISPs, specifically those ISPs that are connected to the host network's backbone. It is noted that Applicant has not disclosed a mechanism by which a user can become associated with an ISP this is not connected to the host network's backbone. The grounds of rejections for these claims have therefore been maintained.

Regarding Applicant 's arguments to the rejection of claim 16 (see Paper No. 10, p. 27), the grounds of rejection has been changed for the same reasons as for claim 5.

Regarding Applicant 's arguments to the rejection of claim 22 (see Paper No. 10, p. 27), the grounds of rejection has been changed for the same reasons as for claim 1.

Regarding Applicant 's arguments to the rejection of claim 23 (see Paper No. 10, p. 28), the grounds of rejection have been maintained for the same reasons as for claim 14.

Regarding Applicant 's arguments to the rejection of claim 25 (see Paper No. 10, p. 29), it is agreed that Xu's system as disclosed does not include a web page linking to an authentication database. The grounds of rejection for claim 25 have therefore been replaced.

Regarding Applicant 's arguments to the rejection of claim 26 (see Paper No. 10, p. 29), the grounds of rejection have been replaced for the same reasons as for claim 5.

Regarding Applicant 's arguments to the rejection of claim 34 (see Paper No. 10, pp. 30 and 31), the grounds of rejection have been replaced for the same reasons as for claim 1.

Regarding Applicant 's arguments to the rejection of claim 42 (see Paper No. 10, p. 32), the grounds of rejection have been replaced for the same reasons as for claim 1.

Regarding Applicant 's arguments to the rejection of claim 43 (see Paper No. 10, p. 33), the grounds of rejection have been maintained for the same reasons as for claim 14.

Regarding Applicant 's arguments to the rejection of claim 46 (see Paper No. 10, p. 34), the grounds of rejection have been replaced for the same reasons as for claim 5.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 5,898,780 to Liu et al. discloses a system for logging on to the Internet using an ISP for which the user does not have an account.

U.S. Patent No. 6,298,234 to Brunner discloses a system for offering Internet access to roaming mobile subscribers.

U.S. Patent No. 6,546,392 to Bahlmann discloses a user interface for managing Internet connections.

15. In view of the fact that several grounds of rejection have been changed that were not necessitated by amendment, and in view of the addition of the double patenting rejections, this action is made as being non-final.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew E. Heneghan whose telephone number is (703) 305-7727. The examiner can normally be reached on Monday-Thursday from 9:00 AM - 5:00 PM Eastern Time. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Morse, can be reached on (703) 308-4789.

Any response to this action should be mailed to:
Commissioner of Patents and Trademarks

P.O. Box 1450
Alexandria, VA 22313-1450

Or faxed to:

(703) 872-9306

Hand-delivered responses should be brought to Crystal Park 2, 2121 Crystal Drive, Arlington, VA 22202, Fourth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

MEH

March 8, 2004

GREGORY MORSE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100